



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,669	02/21/2001	Richard Oliver Kahn	30990156 US	6041

7590 07/09/2004

Allan M. Lowe
c/o Lowe, Hauptman, Gopstein Gilman & Berner
Suite 310
1700 Diagonal Road
Alexandria, VA 22314

EXAMINER

VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,669

Applicant(s)

KAHN ET AL.

Examiner

John M. Villecco

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-17 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2612

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 46. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:
 - Applicant has failed to include a detailed description of Figure 5 in the specification.

Art Unit: 2612

Appropriate correction is required.

Claim Objections

4. Claims 2, 8, and 10 are objected to because of the following informalities:

- Regarding claims 2, 8, and 10, applicant discloses that one of the compression techniques used for reducing the image data stored in memory is to delete the image file in its entirety. However, The Authoritative Dictionary of IEEE Standards Terms, 7th edition, describes a compressed file as “a file that has been transformed in a manner intended to reduce its size without loss of information”. Therefore, in a compressed image file you would never completely delete the image. There would always be some image data left and therefore, it would be impossible to delete the image when compressing it.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 7, 13, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by**

Torres (U.S. Patent No. 6,564,282).

Art Unit: 2612

7. Regarding **claim 1**, Torres discloses a method of increasing storage capacity in a digital image capture device. More specifically, Torres discloses an imaging device (114) which serves as the information record capture mechanism, a memory (354) which serves as the device memory, and a CPU (344) which serves as the controller. In a specific embodiment of the invention, when a user wishes to capture an image when the memory is full, a storage recovery operation takes place. The operation evaluates the compression level of previously saved image files and if they are not sufficiently compressed, further compresses the image files in order to create more space in the memory. See col. 5, line 55 to col. 6, line 12. Additionally, Torres discloses that the user has the ability to prioritize the images so that certain images are compressed before other images. See column 6, lines 13-31. Furthermore, Torres discloses that the system looks at the file extension to determine the level of compression. Therefore, by establishing a priority level the system is also determining how far to compress the image.
8. As for **claim 7**, Torres discloses that a use can establish a priority level based on whether or not certain images are archived (col. 6, lines 18-20). Therefore, the priority level can indicate whether an image is stored elsewhere.
9. With regard to **claim 13**, Torres discloses that an image can be marked so as not be compressed (col. 6, lines 23-25).
10. Regarding **claim 14**, Torres discloses that the designation may be given to an image by the user (col. 6, lines 17-18). Inherently, the buttons and dials (404) would be used to designate specific images.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282).**

13. Regarding claim 15, as mentioned above in the discussion of claim 1, Torres discloses all of the limitations of the parent claim. Additionally, Torres discloses that it is well known in the art to group similar images into categories. See column 5, lines 4-25. However, Torres fails to explicitly state that whole groups of information records may be given a common priority rating. However, one of ordinary skill in the art at the time the invention was made would have found it obvious to assign a specific priority to a group of tagged images so that a user would not have to select every image and give it a priority if a user would like to save every image in a specific category. This would save considerable time and effort in the operation of the camera.

14. **Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Imai et al. (Japanese Publ. No. 09-128276 A).**

15. Regarding *claim 2*, as mentioned above in the discussion of claim 1, Torres discloses all of the limitations of the parent claim. However, Torres fails to explicitly state that one option for compression is deleting the image data. Imai, on the other hand, discloses that it is well known in the art to delete prioritized image data if there is not even free memory to store new image

Art Unit: 2612

data. In the abstract, Imai discloses a recording medium (3), wherein, if the free memory is not enough to store new image data, an erased file selection part (23) selects a file to be erased according to a priority. By deleting the image data instead of compressing it, more memory can be freed up. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to delete the image data instead of compressing it so that more free memory is created.

16. As for *claim 8*, as mentioned above in the discussion of claim 7, Torres discloses all of the limitations of the parent claim. Additionally, Torres discloses that images can be selected for compression if they are already archived (col. 6, lines 18-20). However, Torres fails to explicitly state that deletion of an image is only allowed if the image is stored elsewhere. Imai, on the other hand, discloses that it is well known in the art to delete prioritized image data if there is not even free memory to store new image data. In the abstract, Imai discloses a recording medium (3), wherein, if the free memory is not enough to store new image data, an erased file selection part (23) selects a file to be erased according to a priority. By deleting the image data instead of compressing it, more memory can be freed up. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to delete the image data instead of compressing it so that more free memory is created.

17. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Hosoe et al. (U.S. Patent No. 6,674,468).**

18. With regard to *claim 3*, as mentioned above in the discussion of claim 3, Torres discloses all of the limitations of the parent claim. Additionally, Torres discloses that maintaining the

Art Unit: 2612

quality of specific images may be important to a user. However, Torres fails to specifically disclose that the priority rating includes a predefined permissible compression level. Hosoe, on the other hand, discloses that it is well known in the art to select an image quality level and then limit the level of compression based on the image quality level. See column 9, lines 11-37. This allows a user to select a specific amount of compression in order to maintain a required image quality level. Therefore, one of ordinary skill in the art would have found it obvious to also include an image quality level in the priority rankings of the images so that a specific level of compression is achieved in order to maintain an image quality level.

19. **Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Hosoe et al. (U.S. Patent No. 6,674,468) and further in view of Makishima et al. (U.S. Patent No. 6,549,307).**

20. Regarding *claim 4*, as mentioned above in the discussion of claim 3, both Torres and Hosoe disclose all of the limitations of the parent claim. Additionally, Hosoe discloses that the quality level is set depending upon the "situation and the desire". However, neither of the aforementioned reference specifically discloses that the compression levels are set for defined functional purposes. Makishima, on the other hand, discloses that based upon whether an image is to be printed or displayed a compression level is set. See column 2, lines 31-46. Therefore, the amount of compression can be set based upon the situation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the compression level to be suitable for defined functional purposes so that optimal image reproduction can take place.

Art Unit: 2612

21. As for *claim 5*, Makishima discloses that a user can select a printing mode in which an optimal compression is selected (col. 5, lines 8-60).

22. With regard to *claim 6*, Makishima discloses that a displaying method can be selecting in which an optimal compression rate is selected.

23. **Claims 9, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Oie (U.S. Patent No. 6,188,431).**

24. Regarding *claim 9*, as mentioned above in the discussion of claim 1, Torres discloses all of the limitations of the parent claim. However, neither of the aforementioned references discloses an interface for downloading information records from a remote source. Oie, on the other hand, discloses that it is well known in the art to download images onto a camera from a remote source. More specifically, Oie discloses a camera (1a) which uses a communication terminal (47) to communicate with camera (1b). The camera (1a) sends selected images to camera (1b). By sending images from one location to a camera, the user of the camera is capable of viewing images taken by another user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to download information from a remote source so that one can view images taken remotely.

25. As for *claim 16*, Torres discloses a method of increasing storage capacity in a digital image capture device. More specifically, Torres discloses an imaging device (114) which serves as the information record capture mechanism, a memory (354) which serves as the device memory, and a CPU (344) which serves as the controller. In a specific embodiment of the invention, when a user wishes to capture an image when the memory is full, a storage recovery

Art Unit: 2612

operation takes place. The operation evaluates the compression level of previously saved image files and if they are not sufficiently compressed, further compresses the image files in order to create more space in the memory. See col. 5, line 55 to col. 6, line 12. Additionally, Torres discloses that the user has the ability to prioritize the images so that certain images are compressed before other images. See column 6, lines 13-31. Furthermore, Torres discloses that the system looks at the file extension to determine the level of compression. Therefore, by establishing a priority level the system is also determining how far to compress the image.

Torres, however, fails to specifically disclose that the device includes a communications link for receiving information record captured at a remote information capture device. Oie, on the other hand, discloses that it is well known in the art to download images onto a camera from a remote source. More specifically, Oie discloses a camera (1a) which uses a communication terminal (47) to communicate with camera (1b). The camera (1a) sends selected images to camera (1b). By sending images from one location to a camera, the user of the camera is capable of viewing images taken by another user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to download information from a remote source so that one can view images taken remotely.

26. As for *claim 17*, Torres discloses that the user is able to set a priority rating based upon whether or not the image quality is important. See column 6, lines 15-30. The predetermined criteria is the image quality. Furthermore, the CPU (344) would have to do some type of calculation in order to associate the tag with the image.

Art Unit: 2612

27. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Oie (U.S. Patent No. 6,188,431) and further in view of Hosoe et al. (U.S. Patent No. 6,674,468).**

28. Regarding *claim 11*, as mentioned above in the discussion of claim 9, both Torres and Oie disclose all of the limitations of the parent claim. Additionally, Torres discloses that maintaining the quality of specific images may be important to a user. However, neither of the aforementioned references discloses that the priority rating includes a predefined permissible compression level. Hosoe, on the other hand, discloses that it is well known in the art to select an image quality level and then limit the level of compression based on the image quality level. See column 9, lines 11-37. This allows a user to select a specific amount of compression in order to maintain a required image quality level. Therefore, one of ordinary skill in the art would have found it obvious to also include an image quality level in the priority rankings of the images so that a specific level of compression is achieved in order to maintain an image quality level.

29. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torres (U.S. Patent No. 6,564,282) in view of Oie (U.S. Patent No. 6,188,431) and further in view of Hosoe et al. (U.S. Patent No. 6,674,468) and Makishima et al. (U.S. Patent No. 6,549,307).**

30. Regarding claim 12, as mentioned above in the discussion of claim 11, Torres, Oie, and Hosoe disclose all of the limitations of the parent claim. Additionally, Hosoe discloses that the quality level is set depending upon the "situation and the desire". However, neither of the aforementioned reference specifically discloses that the compression levels are set for defined functional purposes. Makishima, on the other hand, discloses that based upon whether an image

Art Unit: 2612

is to be printed or displayed a compression level is set. See column 2, lines 31-46. Therefore, the amount of compression can be set based upon the situation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the compression level to be suitable for defined functional purposes so that optimal image reproduction can take place.

Allowable Subject Matter

31. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

32. The following is a statement of reasons for the indication of allowable subject matter:

Regarding *claim 10*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that deletion of an information record by the controller is only permissible if the information record is a downloaded information record.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (For either formal or informal communications intended for entry. For informal or draft communications, please label **"PROPOSED"** or **"DRAFT"**)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington VA, Sixth Floor (Receptionist).

Art Unit: 2612

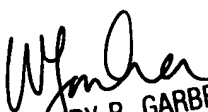
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco
June 15, 2004



WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600